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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,971	03/04/2002	Carl A. Caspers	33062.PM15891	1772

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/13/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,971

Applicant(s)

CASPER ET AL

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☒ Claim(s) 2, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 8, 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Applicant's remarks have been considered. In regard to the Advisory Action mailed on September 15, 2003, the examiner was trying to make the point that the Applicant's assertion that "the valve 78 is shown external to and separate from the plate/socket attachment 200" (Paper No. 8: page 5, second to last paragraph) has no basis of support in the specification, which is utterly silent as to how the valve 78 is affixed to the plate/socket attachment 200. And Figure 21 on its own does not offer any explanation as to how the embodiment illustrated is any more "valveless" than that of Slemker et al. The Applicant refers to corresponding US 2002/0091449 A1, but the specification mentions "valveless" only once, and there is certainly no definition (MPEP §§ 608.01(o) and 2111.01) of what is meant by "valveless plate/socket attachment". Moreover, Figures 21 and 22 represent different embodiments, so it is not seen how the supposed absence of a valve in one embodiment provides support for the deletion of a valve in the other embodiment. In fact, the apparent assertion that the embodiment of Figure 22 does not have some sort of valve associated with the element 200 is questionable, since a vacuum source 70 would generally require at least one valve for its operation.

The amendment filed on December 8, 2003, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure; 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material not supported by the original disclosure is the deletion of the valve 78 in Figure 21 so as to transform the embodiment into a supposedly "valveless" one. Therefore, the proposed drawing correction has **not** been entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Slemker et al., US 6,287,345 B: Figure 1; column 6, lines 9-12 and 44-48; column 4, lines 20-26.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slemker et al., US 6,287,345 B. Regarding claim 9, a vacuum reservoir, well known in the art, in conjunction with the “electronically or hydraulically controlled device” (column 6, line 48) would have been obvious in order to conserve power. Regarding claim 10, a weight-actuated vacuum pump was well known and would have been obvious in order to avoid the need for external power altogether and would have been motivated by column 5, lines 45-53, or column 6, line 47, of Slemker et al.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slemker et al., US 6,287,345 B1, in view of Fishman et al., US 5,007,937. An annular seal between the liner and the socket would have been obvious from the Fishman teaching in order to accommodate, for example, an amputee who wears a stump sock, with further motivation having been provided by

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the need for a seal, as expressed by Slemker et al. at column 6, line 11, and by the advantages set forth by Fishman et al. at column 2, lines 3-5 and 10-11, for example.

Claims 3, 5, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slemker et al., US 6,287,345, in view of Caspers, US 5,735,906. Regarding claim 3, Slemker et al. are silent as to particular values for the vacuum, but pressures lower than ten inches of mercury below atmospheric pressure were known in the art, as seen from column 7, lines 25-27, of Caspers, and would have been obvious for Slemker et al. particularly since vacuum is used to don the prosthetic limb (Slemker et al.: column 6, lines 49-53), with one of ordinary skill having been left to devise a range of vacuum levels. Regarding claim 5, such a suspension sleeve was likewise well known in the art (e.g., Caspers: column 6, lines 30-35) and would have been an obvious substitute or supplement as a seal and/or attachment means. Regarding claim 6, the liner being a non-foamed, nonporous polyurethane would have been an obvious variant in view of its common use and advantages (e.g., Caspers: column 6, lines 47-55). Regarding claim 11, a thin nylon sheath would have been obvious in order to assist donning (e.g., Caspers: column 7, lines 5-9).

Claims 2, 12, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-15 are allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

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37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
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